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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,790	09/19/2001	Paul Laurence Cervi	13533-002001/F/USP81213	2047

26161 7590 07/23/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 07/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,790

Applicant(s)

CERVI, PAUL LAURENCE

Examiner

Brian Szmaj

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-27, 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 1, 8, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 2-7, 9-15, 18, 19 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

1. Claim 29 is objected to because of the following informalities: In lines 29-30 of the claim, "aid elongated cannula" should read as "said elongated cannula".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 8, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleming, III.

Fleming, III discloses a bone marrow biopsy device and further discloses a handle for inserting an instrument into tissue; a single hollow tube configured for cutting and receiving a tissue sample coupled to the handle; the tube having a bore defining a tissue-receiving space for the tissue sample, a substantially rigid tip, and an outer wall configured to contact the tissue, the outer wall being provided with an abrading formation extending in an axial direction along the tube to abrade the tissue; thereby allowing the tip of the hollow tube to be laterally displaced within the bone marrow tissue to facilitate retrieval of the tissue; the tip of the tube further comprises a sample

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detacher to assist in detaching a base portion of the tissue sample from adjoining tissue; the tube bore extends through the handle; and the handle is adapted for connection to a suction device to the tube bore. See Column 7, lines 23-32 and 44-58; Column 12, lines 28-39 and 56-64.

Allowable Subject Matter

4. Claims 2-7, 9-15, 18, 19 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: After reviewing the claims. Claims 21-27, 29 and 30 were found to be allowable since no prior art could be found concerning or suggesting a method for sampling a substance with a biopsy needle and a biopsy needle comprising: gyrating the sampling tip such that the substance is abraded to allow the sampling tip to be laterally displaced to weaken the connection between the sample and the connecting tissue; means for coupling the needle to a rotary motor drive; and the connector attachment having a shaft affixed to the proximal end, the knob and shaft being sized to fit within the orifice of the cannula handle distally of the knob sized to fit an electric drill or an electric screwdriver proximally.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj who's telephone number is (703) 308-

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3737 and group fax number is (703) 308-0758. The examiner can normally be reached on Monday-Friday, with second Fridays off.

A handwritten signature in black ink, appearing to be 'BS', located above the date.

BS
July 17, 2003

A handwritten signature in black ink, appearing to be 'Max F. Hindenburg', located above the printed name and title.

MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700